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KNOBBE MARTENS OLSON & BEAR LLP			JANVIER, JEAN D	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/825,772	CHANOS, GEORGE J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JEAN JANVIER	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 August 2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 30-45 and 55-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 30-45 and 55-60 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____ .                        |

### **Response to Applicant's Arguments**

**In general**, the claims are broadly interpreted during prosecution. Indeed, according to the MPEP, a broad and reasonable interpretation should be applied to the claims (claim language or claim element).

**First**, Applicant argues, with respect to at least independent claims 30 and 55, that “Yost is not providing a commercial product for purchase by a retail consumer and it is rather giving business personnel customizable reports from data related to the personnel’s business” (col. 8: 1-5). At best, claim 30 recites receiving from a potential consumer a selection of a consumer product available for purchase through commerce by the potential consumer of the product. The claim, contrary to the Applicant’s contention, never positively recites the act or the step of purchasing the selected product by the potential consumer. To this end, Yost discloses a system for automatic generation of personalized output from an on-line analytical processing system. The system processes at least one scheduled service in an on-line analytical processing system and generates personalized output based on personalization information for subscribers of the service to one or more subscriber output devices. The system enables a user to specify global and service-specific personalization information including specification of multidimensional filters to be applied to services and the specification of trigger criteria to be satisfied before output is generated. Personalization information may also be set for each output device for a particular subscriber (see abstract; fig. 3). Yost discloses, as described in conjunction with fig. 3, a process for naming by a consumer a service (product), selecting type of service (product) by the consumer, selecting a schedule for service (or an alert service) for delivering information regarding the selected service (product) using push technology, specifying content (subject area

or area of interest) and specifying personalization type (delivery criteria or parameters such as output device format) when delivery conditions or alert criteria are satisfied or met (fig. 3: col. 10: 15-67; col. 11: 1 to col. 12: 27). Broadly interpreted, the latter reads on the argued claims (i.e. claims 30 and 55) or more specifically on the step of receiving from a potential consumer a selection of a consumer product (service) available for purchase (service available for purchase) through commerce by the potential consumer of the product (subscriber of the service). Further, Yost discloses that multidimensional qualifications enable the user to indicate general subject areas, related to a selected service (product), or perspectives on data/content such as timing, geography or product corresponding to the selected service (col. 6: 48-51). The terms service and product are often used interchangeably in the art. Additionally, service may be considered as a type of product.

**Second,** Applicant argues that “Carpenter fails to teach or suggest narrow consumer subscription to products or services”. However, the argued claims, namely claims 30 and 55, never recite “any narrow consumer subscription”. It appears here that the Applicant is improperly reading limitations from the specification into the claimed invention. Once again, although the Examiner interprets the claims in view of the specification, however, the Examiner does not read limitations from the specification into the claimed invention (See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)).

Carpenter discloses, inter alia, a system for navigating by a customer or subscriber an online information system. The subscriber provides topic (selecting a topic or product) and action preferences (conditions or criteria or personalization data) to traverse to a customized content area in which related tasks may be completed (before a subject area or subscribed subject

matter of interest can be delivered to the customer). Customized content areas are reached after the subscriber makes three or fewer selections (before a subject area or subject matter related to the selected topic can be outputted to the customer or subscriber). Paths to customized content areas are similar for all combinations of topics and actions so that the subscriber learns quickly how to navigate to any area of the information service (See abstract).

Further, contrary to the Applicant's contention, Carpenter discloses a method and a system wherein a subscriber navigates a computer information service adapted to offer at least product information retrieval, electronic mail and services, comprising the steps of:

providing a computer application program for prompting said subscriber and determining said subscriber's responses;

prompting said subscriber to select one of a plurality of topics (selecting a product from a lists);

determining said subscriber's response to said topic prompt;

prompting said subscriber to select one of a plurality of subtopics (selecting one or more subject areas) related to one or more selected topics;

determining said subscriber's response to said subtopic prompt (determining if the subscriber has subscribed to at least one subject area or subtopic);

prompting said subscriber to select one of a plurality of actions (selecting subscription conditions);

determining said subscriber's response to said action prompt; and

**providing said subscriber or user with access to a customized content area (formatting a deliverable for the consumer based on the consumer's selections related to a subscription request or a request for a consumer product information associated with a specific topic or product) based upon the combination of said subscriber's responses to said topic prompt (receiving a product selection from the user or subscriber), said subtopic prompt (receiving a selection of a subtopic/subcategory or subject matter/subject area, related to the topic or product, from the user) and said action prompt to said computer application program (receiving subscription conditions or delivery parameters from the user) (delivering the product information to the consumer or subscriber, via a customized interface, when the delivery parameters or subscription conditions are met/satisfied or subsequent to at least the user's or subscriber's action).**

See in general col.5: 10 to col. 7: 15; col. 7: 33 to col. 8: 28; col. 8: 38 to col. 9: 33; figs. 1-7; See claims 1-33 of the present reference.

**Third**, when the claims are amended and the Applicant's remarks are based on the amendment, the Examiner does not have to expressly respond to the arguments for the arguments are addressed in the Office Action that is updated to reflect the amendment. In this case, the Examiner can refer the Applicant to the Office Action, which indeed provides an answer to the Applicant's remarks in the form of a prior art disclosure. Thus, it can be concluded that the Applicant's arguments are moot in view of a new ground of rejection since the rejection was updated to reflect the amendment. In other words, the Applicant's arguments were addressed in the updated Office Action. Contrary to the Applicant's position, the Examiner does not have to drop a prior art rejection to trigger a new ground of rejection.

**Fourth**, the request for the interview is not timely. In fact, the best way to request an interview is to contact the Examiner by telephone to thereby schedule such interview. It is never a good idea to include an interview request with a response to an Action for by the time the Examiner picks up the case or a two-monther for a decision it is too late to grant such interview.

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not convincing and thus, the current **Office Action has been made Final.**

**Detailed Action**

**Specification**

**Status of the claims**

Claims 30-45 and 55-60 are currently pending in the Application while claims 1-29 and 46-54 are being canceled.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 30-35, 36-45 and 55-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Yost, USP 6,154,766A.**

As per claims **30-35, 36-45 and 55-60**, Yost discloses a system for automatic generation of personalized output (selection) from an on-line analytical processing system. The system processes at least one scheduled (delivery) service in an on-line analytical processing system and generates personalized output based on personalization information for subscribers of the service (product) to one or more subscriber output devices. The system enables a user to specify global and service-specific personalization information (user's selection information) including specification of multidimensional filters to be applied to services and the specification of trigger criteria to be satisfied before output (final selection) is generated. Personalization information may also be set for each output device for a particular subscriber (receiving a user's selection information, generating an output thereof based on the user's or subscriber's received selection information and delivering the generated output or the final product according to a scheduled delivery-See abstract; figs. 1-3).

In general, Yost discloses a system and method for automatic broadcasting of personalized reports processed by an on-line analytical processing system reports to subscriber devices, including electronic mail, pagers, personal digital assistants (PDA), facsimiles, printers,

telephones, and mobile phones, based on subscriber-specified or administrator-specified criteria (col. 1: 23-29).

The system is configured to broadcast personalized messages to subscribers based on criteria (**subscription conditions or delivery parameters**) established by the subscribers or a system administrator when those criteria are met or determined to be satisfied by an on-line analytical processing system and enable a user or subscriber to personalize the content of information (**service or product**) broadcast from a data warehouse through **a subscription interface system that contains references to the contents of the data warehouse.**

The system comprises a broadcast module that connects to an on-line analytical processing (OLAP) system comprising a server system for accessing information in one or more data warehouses to perform report analysis. The broadcast module may enable the defining of a service (a "service" as used here should be understood to include one or more reports that are scheduled to be run against one or more data warehouses, relational databases, files in a directory, information from a web or file transfer protocol site, or information provided by a custom module, by a server system). **These services may be subscribed to by users (subscribers) or user devices to enable the broadcast module to determine who should receive the results of a service (product).**

**The broadcast module enables the creation of a service, the scheduling of the service, subscription of users to the defined services, generation of reports for the service, formatting of outputs of the service and broadcasting of messages based on the output for the service, among other functions. A subscription interface module may be provided to**

**enable users to select the services (products), from a list, a menu or a plurality of services, they want to subscribe to (receiving at least a user's or consumer's selection of a service or product), the schedule (delivering parameters or conditions) on which they want to receive the contents of the service, and the personalization criteria to use for personalizing their content (delivering parameters or conditions). A personalization module may be provided that enables subscribers to personalize the content of an individual service (content selection information) to which the subscribers are subscribing or to all services (or service categories) to which the subscribers subscribe.** The broadcast module may be connected to a plurality of user devices including a personal digital assistant (PDA), facsimile, printer, pager, mobile phone, telephone, electronic mail, and web page output.

Further, according to one embodiment, Yost teaches a system for automatically generating output from an on-line analytical processing system based on scheduled services specified by subscribers. The system processes scheduled services in an on-line analytical processing system with each service comprising at least **one query** to be performed by the on-line analytical processing system. **The system then automatically forwards output from the services to one or more subscriber output devices specified for that service.** Users or subscribers may define new services (service categories), including the schedule (time of delivery) of the services and the type, such as alert services or scheduled **services (service subcategories, service areas or subject areas)** and may also subscribe to the services provided by the system (**receiving a subscription to a service area/subject area, related to a service/product selected by a user, customizing the service area based on the user's specifications or criteria or delivery parameters or subscription conditions and**

**subsequently formatting and delivering the customized content of the service area (i.e. service alert or schedule service), related to the selected service/product, to the user, based on the type of receiving device used by the user).**

(See abstract; figs 1-4; col. 3: 56 to col. 5: 33; col. 8: 13-59).

**All in all, Yost discloses** a broadcast module enables the creation of a service, the scheduling of the service, subscription of users to the defined services (**products**), **having service types or subcategories or subject areas or service areas**, generation of reports for the service, formatting of outputs of the service and broadcasting of messages based on the output for the service, among other functions. Yost further discloses **a subscription interface module provided to a user to enable him/her to select at least one service (product) from a plurality (list) of services (products), having service types or subcategories or subject areas or service areas, he wants to subscribe to, the schedule (delivery parameters or subscription conditions) on which he wants to receive the formatted contents of the subscribed service areas (subject areas) related to the selected service, and the personalization criteria (delivery parameters or subscription conditions) to use for personalizing (formatting) his selected subject area or service area/service type from a plurality of service areas or subject areas corresponding to a selected service.** A personalization module may be provided that enables a subscriber to personalize the content of an individual service area or service type of a selected service to which the subscriber is subscribing to or to all services (service types or service areas related to one or more services or products) to which the subscriber subscribes. The broadcast module or delivery system may be connected to a plurality of user devices including a personal digital assistant (PDA), facsimile, printer, pager, mobile phone, telephone, electronic

mail, and web page output and the content of a selected subject area or service area or service type (e.g. service alert or schedule service) related to the requested (selected) service (product) is formatted to be delivered to one of the user's devices as cited above (col. 9: 35-51; col. 10: 48-67; col. 11: 45 to col. 12: 15; figs. 1-3). **(receiving a subscription to a service area/subject area, related to a service/product selected by a user, customizing the service area based on the user's specifications or criteria or delivery parameters or subscription conditions and subsequently formatting and delivering the customized content of the service area (i.e. service alert or schedule service), related to the selected service/product, to the user, based on the type of receiving device used by the user).**

**Claims 30-45 and 55-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Carpenter, US Patent 6,065,047A.**

As per claims 30-45 and 55-60, Carpenter discloses a system for navigating an online (consumer) information system. Subscribers provide topic (product) and action preferences to traverse to a customized content area in which related tasks are completed. Customized content areas are reached after subscribers make three or fewer selections. Paths to customized content areas are similar for all combinations of topics, subtopics (subject areas) and related actions so that subscribers can learn quickly how to navigate to any area of the information service (see abstract).

Here, a navigational method of the present system is based on a model of computer/user interaction in which users **are graphically prompted for a topic** (prompting the consumer to select a topic product/document) of interest, **a subtopic** (subject matter or subcategory of the

main topic or product/document) of interest and an associated action **including a selection** (receiving a product selection from a user and, in response to the user's selection, arranging or organizing retrieved information into specific subtopic or subject areas, receiving a subscription or a selection of a subtopic or subject area from the user and formatting and delivering to the user the user's requested information via a customized graphical user-interface or customized content based at least on the subtopic or subject area selected by the user or consumer). Subscribers may make their selections in one of several orders. Once the three selections have been made, the information system assists subscribers by presenting customized content areas in which their specific goals may be accomplished (formatting and presenting/delivering the user's selection of a specific subtopic or subject area into a customized content area or customized interface).

See col. 3: 35-47, col. 4: 10-31; figs 1, 4, 6 and 10.

In general, Carpenter discloses a method and a system wherein a subscriber navigates a computer information service adapted to offer at least product information retrieval, electronic mail and services, comprising the steps of:

providing a computer application program for prompting said subscriber and determining said subscriber's responses;

prompting said subscriber to select one of a plurality of topics (products);

determining said subscriber's response to said topic prompt;

prompting said subscriber to select one of a plurality of subtopics (subject areas) related to one or more selected topics;

determining said subscriber's response to said subtopic prompt (determining if the subscriber has subscribed to at least one subject area or subtopic);  
  
prompting said subscriber to select one of a plurality of actions (subscription conditions);  
  
determining said subscriber's response to said action prompt (**determining if the subscription conditions are being met**); and  
  
**providing said subscriber or user with access to a customized content area (formatting a deliverable for the consumer based on the consumer's selections related to a subscription request or a request for a consumer product information associated with a specific topic or product) based upon the combination of said subscriber's responses to said topic prompt (receiving a product selection from the user or subscriber), said subtopic prompt (receiving a selection of a subtopic/subcategory or subject matter/subject area, related to the topic or product, from the user) and said action prompt to said computer application program (receiving subscription conditions or delivery parameters from the user) (delivering the product information to the consumer or subscriber, via a customized interface, when the delivery parameters or subscription conditions are met/satisfied or subsequent to at least the user's or subscriber's action).**

See in general col.5: 10 to col. 7: 15; col. 7: 33 to col. 8: 28; col. 8: 38 to col. 9: 33; See claims 1-33 of the present reference.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**USP 5,796,395A to De Hond** teaches a system for and a method of publishing and searching interests of individuals, the method including providing a memory bearing or storing software for performing the following: providing to a user a request for data by providing a plurality of selectable and different graphics icons respectively having the appearance of a house (**providing a list of product choices to a user or subscriber), receiving a selection of one of the listed product or product choices from the user**, adding the selection to a database and associating the selection with the user who made the selection, communicating to the user who selected a house icon a list of possible interests of the user, **receiving a selection of interests from the user (receiving a selection of a subject area, related to the selected product choice, from the user)**, adding the selected interests (**subject areas**) to the database and associating the selected interests with the house icon **or product** selected by the user who selected the interests, communicating to a user a form for use in requesting a search of the database, and generating graphics having the general appearance of a plurality of houses after the search is performed, in which the houses are respectively selectable by the user, and communicating to the user who uses the search request form the interests of the user associated with a house if that house is selected (See abstract).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Jim Myhre, can be reached at (571) 272- 6722.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

11/20/08

/J. J./

/Jean D. Janvier/  
Primary Examiner, Art Unit 3622